



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,325	06/10/1998	GENE EGGLESTON	PD05513AWD01	9524

20280 7590 01/11/2002

MOTOROLA INC
600 NORTH US HIGHWAY 45
LIBERTYVILLE, IL 60048-5343

EXAMINER

CARDONE, JASON D

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/095,325

Applicant(s)
Eggleston et al.

Examiner
Jason D. Cardone

Art Unit
2152



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 18, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-68 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☒ Interview Summary (PTO-413) Paper No(s). 21, 22
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: See Attached Office Action

Art Unit: 2152

DETAILED ACTION

1. The request filed on 9/18/01 for a Continued Prosecution Application (CPA) under 37 CAR 1.53(d) based on parent Application No. 09/095,325 is acceptable and a CPA has been established. An action on the CPA follows.

2. This action is responsive to the amendment of the applicants (Paper No. 19) filed on 9/18/01. Claims 33-68 are presented for further examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 33-68 are objected to under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. The claimed invention as a whole may not be adequately described if the

Art Unit: 2152

claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. The Federal Circuit has pointed out that under United States law, a description that does not render a claimed invention obvious cannot sufficiently describe the invention for the purposes of the written description requirement of 35 U.S.C. 112. *Eli Lilly*, 119 F.3d at 1567, 43 USPQ2d at 1405. Compare *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997). While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed. The independent claims 33, 54-56, 60, 64, and 65 disclose receiving a reply/forwarding message at a host system and configuring the reply message using the first email address for the user of a mobile client as the address originating the reply messages, wherein messages generated at either the host system or the mobile client share the first email address. There has been a reference to the specification page 7, line 23 through page 8, line 7 to describe the use messages generated at either the host system or the mobile client share the first email address.

Art Unit: 2152

The paragraph points out (with figure 1) "the communications server 110 to advantageously maintain the same session with the host 115 that the client 105 typically enjoys when connected to the LAN/WAN. Thus, by use of the server 110 the client 105 can achieve a virtual session with the host 115 LAN, but at a substantial reduction in the cost of communicating via the wireless network and PDN 130".

However, one of skill in the art at the time the application was filed would not have recognized that application was in possession of the invention as claimed in view of the disclosure of the application as filed, since an explicit limitation (ie. messages generated at either the host system or the mobile client share the first email address) in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v.

Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed.Cir. 1998). See also In re Wright, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989). "By use of the server 110 the client 105 can achieve a virtual session with the host 115 LAN" does not specifically disclose the messages generated at either the host system or the mobile client share the first email address. The specification discloses a "virtual session" but does not disclose how the generated messages would share the same address as the first email address. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the

Art Unit: 2152

reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.””) (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential. See, e.g., *Johnson Worldwide Associates Inc. v. Zebco Corp.*, 175 F.3d at 993, 50 USPQ2d at 1613; *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d at 1479, 45 USPQ2d at 1503; *Tronzo v. Biomet*, 156 F.3d at 1159, 47 USPQ2d at 1833.

5. Therefore, independent claims 33, 54-56, 60, 64, and 65 (and their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention

Request for Interference

6. The office has acknowledged the request for interference by applicants, filed 9/18/01 (Paper No. 20) but (as shown above) the instant claims are not in order for allowance at this time. See MPEP § 2301.1(c).

Art Unit: 2152

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone, whose telephone number is (703) 305-8484. The examiner can normally be reached on Monday through Thursday from 9:00am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 (After Final Communications)

(703) 746-7239 (Official Communications)

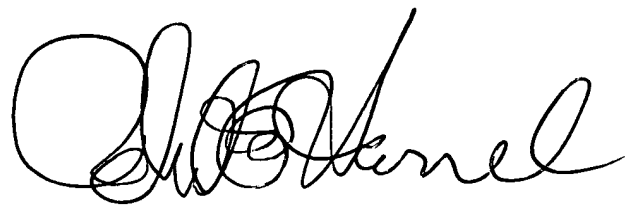
(703) 746-7240 (For Status inquiries, Draft Communications)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.



Jason D. Cardone

January 9, 2002



**ROBERT B. HARRELL
PRIMARY EXAMINER**